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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,775

08/25/2006

Kiyomi Sakamoto

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2464

22852

7590

10/29/2009

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EXAMINER

OLADAPO, TAIWO

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

10/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/590,775	Applicant(s) SAKAMOTO ET AL.	
	Examiner TAIWO OLADAPO	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The amendment dated 06/30/2009 has been considered and entered for the record. The amendment overcomes previous rejections which are hereby withdrawn. New rejections made below in view of amendment.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1 – 3, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujita et al. (US 2006/0073989) in view of Butke et al. (US 5,843,873)

6. In regards to claims 1 – 3, Fujita teaches a grease composition for automobile electrical equipment comprising base oil and thickener (abstract), carbon black with a mean particle size of preferably 10 – 300nm [0037], extreme pressure (EP) additives such as zinc dithiophosphate and organomolybdenum compounds [0041], and salts of organic acids [0040]. Fujita does not recite that the composition comprises carbonate overbased fatty acid salt complex.

Butke is added to teach lubricant and grease compositions as in the invention of Fujita (column 2 lines 22 – 32). Butke teaches the composition comprises surfactants or dispersants (column 10 lines 10 – 15). In Examples 32 and 59, Butke teaches blends comprising surfactants such as calcium carbonate-overbased tall oil fatty acid carboxylate (P) and calcium carbonate-overbased fatty acid carboxylate (WW) used in the composition (Table 3 & 4).

It would have been obvious for one of ordinary skill in the art at the time of the invention to have used the surfactants taught by Butke in the grease composition of Fujita, as Butke teaches they are suitable for use in greases.

7. Claims 1 – 3, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoshita et al. (US 6,432,889) in view of Iso et al. (US 2002/0076125) and further in view of Butke et al. (US 5,843,873)

8. In regards to claims 1 – 3, Kinoshita teaches a grease composition for a constant velocity (CV) joint comprising a base oil, thickener, extreme pressure agents such as phosphorus and

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molybdenum compounds (abstract, column 1 lines 4 – 6, and column 7 lines 40 – 47). The grease comprises carbonated metal sulfonates (column 5 lines 34 – 44). Kinoshita does not teach that the grease comprises carbon black.

Iso teaches a grease composition for rolling bearing which is a part in constant motion (abstract). Iso similarly teaches the grease comprises carbon black having a mean particle size of 10 to 300nm [0029]. Kinoshita and Iso combined do not recite that the composition comprises carbonate overbased fatty acid salt complex.

Butke is added to teach lubricant and grease compositions for use in various applications such as to lubricate transaxles which utilize CV joints as in the invention of Fujita (column 2 lines 22 – 32). Butke teaches the composition comprises surfactants or dispersants (column 10 lines 10 – 15). In Examples 32 and 59, Butke teaches blends comprising surfactants such as calcium carbonate-overbased tall oil fatty acid carboxylate (P) and calcium carbonate-overbased fatty acid carboxylate (WW) used in the composition (Table 3 & 4).

It would have been obvious for one of ordinary skill in the art at the time of the invention to have used the surfactants taught by Butke in the grease composition of Kinoshita, as Butke teaches they are suitable for use in greases for transaxle applications which have CV joints. One of ordinary skill in the art at the time of the invention would have used the solid lubricant taught by Iso in the invention of Kinoshita, because Iso provides solid carbon black lubricants with suitable particle size for use in greases.

Response to Arguments

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9. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant correctly asserts that neither Fujita or Kinoshita and Iso combined teach the amended claim limitation requiring a complex of fatty acid salt overbased by a carbonate, thus overcoming the previous rejections. However, Butke is added to teach carbonate overbased fatty acid salt complexes for use as additives in grease compositions. Therefore the argument is moot.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAIWO OLADAPO whose telephone number is (571)270-3723.

The examiner can normally be reached on 8:00 - 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TO

/Glenn A Caldarola/
Acting SPE of Art Unit 1797